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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/084,460	02/28/2002	Steven W. Trovinger	10014012	4991

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HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER

HENDERSON, MARK T

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/084,460

Applicant(s)

TROVINGER, STEVEN W.

Examiner

Mark T Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 March 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4,5,22,25-31,33 and 34 is/are allowed.
- 6) ☒ Claim(s) 1,3,6-21 and 23 is/are rejected.
- 7) ☒ Claim(s) 24 and 32 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Attachment I.

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## **DETAILED ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9306. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 1, 14, 21, 22, 25, 34 have been amended for further examination. Claim 2 has been canceled.

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***Terminal Disclaimer***

2. The terminal disclaimer filed on March 11, 2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of Patent No. 6,550,756 has been reviewed and is accepted. The terminal disclaimer has been recorded.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3, 6, 14, 15, and 18-20 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Weber (4,735,406).

Weber discloses in Fig. 1, 3 and 4 and in Attachment I, a booklet maker and a method of making booklets comprising: a pivotable collecting device (3a); a reciprocating transferring device (28) including a displaceable clamping component (32) which clamps the folded sheet (Col. 7, lines 50-53), wherein the reciprocating transferring device reciprocates along a non-linear path

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(arc path due to cam rotating) to deliver and secure a folded sheet to the collecting device; wherein the collecting device pivots (around hub (2)) to receive the folded sheet material such that portions are supported by different opposite sides (3a and 3b) of the collecting device (3); wherein the supporting sides (A and B) are arranged on opposite sides of the collecting device (3) and pivots reciprocatingly about an axis (1) positioned between the two supporting sides of one (3a) of the plurality of collecting devices (3n); wherein the collecting device (3) converges at a supporting edge (seen in Fig. 3); transferring additional folded sheets to the collecting device wherein an inner fold edge of each sheet is received by an outer fold edge of a previously received sheet (Col 8, lines 4-24); stapling the stack of folded sheet material (Col. 8, line 24).

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 7-21, and 23 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Allan et al (6,099,225) in view of Weber.

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Allan et al discloses in Fig. 1, 2 and 4, a booklet maker and a method of making booklets comprising a collecting device (460) including two supporting sides, a transferring device (400), a folding device (430) for establishing a fold (240A) in a trimmed sheet material (wherein Fig. 2 discloses that the sheet is trimmed (220) by cutting (450) before it is folded); a collecting device (460); an input feed device (210) connected to an output tray (not shown) of a printing device (110); and a processing unit (Col. 4, lines 20-67).

However, Allan et al does not disclose a pivotable collecting device and a reciprocating transferring device; wherein the collecting device pivots about an axis positioned between the two supporting sides.

Weber discloses in Fig. 1, 3 and 4, a booklet maker and a method of making booklets comprising: a reciprocating ( returns back to input conveyor (20)) pivotable collecting device (3a); a reciprocating transferring device (28) including a displaceable clamping component (32) which clamps the folded sheet (Col. 7, lines 50-53), wherein the transferring device reciprocates along a non-linear path (arc path due to cam rotating) to deliver and secure a folded sheet to the collecting device; wherein the collecting device pivots (around hub (2)) to receive the folded sheet material such that portions are supported by different opposite sides (A and B) of the collecting device (3a); wherein the supporting sides (A and B) are arrange on opposite sides of the collecting device (3) and pivots reciprocatingly about an axis (1) positioned between the two supporting sides of one (3a) of the plurality of collecting devices (3n); wherein the collecting device (3) converges at a supporting edge (seen in Fig. 3); transferring additional folded sheets to

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the collecting device wherein an inner fold edge of each sheet is received by an outer fold edge of a previously received sheet (Col 8, lines 4-24); stapling the stack of folded sheet material (Col. 8, line 24) which forms a hole.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Allan et al's booklet maker and method of making booklets with a reciprocating transferring device and a pivotable collecting device as taught by Weber for the purpose of providing an alternative means in which to convey a sheet material from the folding device to a collecting device.

In regards to **Claim 21**, the method in which transferring device delivering and pivoting does not structurally limit the claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process (see MPEP 2113). Therefore, it would be obvious to deliver and pivot the sheet in any desired manner.

***Allowable Subject Matter***

5. Claims 4, 5, 22, 25-30, 31, 33 and 34 are allowed.

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6. The following is a statement of reasons for the indication of allowable subject matter: No prior art of record discloses a system for making booklets comprising a folding device; a saddle shaped pivotable collecting device; a rotatable transferring device; and a collecting drive for clamping a portion of the folded sheet material against the collecting device and for advancing the portion along a side of the collecting device; and including all of the other limitations of the independent claim.

7. Claims 24, and 32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### *Response to Arguments*

8. Applicant's arguments filed on September 24, 2004 have been fully considered but they are not persuasive.

In regards to applicant's argument that the Weber reference does not disclose a reciprocating collecting device, the examiner submit that Weber does indeed disclose a reciprocating collecting device. As stated above, Webster's dictionary defines the term "reciprocating" as "*to make a return for something*", however it does not mean that it has to travel the same or opposite path. The Weber's collecting drive is reciprocating since it rotates



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(pivots) and returns to the point of sheet entry (20). Weber's device also discloses a pivotable collecting device (3a), wherein the first axis (1) is between the two support sides (A and B) of a particular collecting supporting segment (3a out of a plurality of collecting devices 3n). Applicant may wish to disclose the pivoting action in further detail. Applicant must further disclose the reciprocating process in further detail.

Therefore, the rejection has been maintained.

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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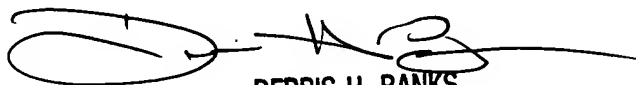
**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (571)272-4477. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (571) 272-4483. The fax number for TC 3700 is (703)-872-9306.



MTH

June 8, 2005



DERRIS H. BANKS  
SUPERVISORY PATENT EXAMINER  
BIOLOGY CENTER 3700

